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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,593	08/29/2001	Masaharu Nishida	NIP-243	5020

7590

03/08/2004

MATTINGLY, STANGER & MALUR, P.C.

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EXAMINER

GAKH, YELENA G

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/940,593

Applicant(s)

NISHIDA ET AL.

Examiner

Yelena G. Gakh, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

1. Preliminary Amendment filed on 07/16/02, is acknowledged. Claims 7-9 are cancelled without prejudice. Claims 1-6 are pending in the application.

### *Specification*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The specification is objected to as not being written “in such full, clear, concise, and exact terms as to enable any person skilled in the art” to practice the invention in its best mode. For example, it is not clear, what the expression “parameters on the required reagents ... are to be registered on an inspection item basis” means. What is the “inspection item basis” in the present context? Does it mean that the parameters are registered to be compared for inspection? Or are they used for inspecting an analytical instrument? Further, it is not clear, what are “batch-registered reagent-dependent parameters corresponding to the particular specification of the analytical apparatus” (page 4, lines 23-24)? What type of parameter batches are disclosed? Of different reagents from the same company? Of the same reagent from different companies? The parameter batches defined by the tests? There is not definite explanation of such terminology. Moreover, as can be concluded from the first seven pages of the specification, the registration is supposedly conducted for the reagents. But on page 8, lines 13-16 the specification discloses, “the registration is conducted for either the analytical apparatus of the corresponding analytical apparatus manufacturer before the apparatus is delivered, or the analytical apparatus that was delivered to the user”. This arises a question, what is the registration conducted for? It looks like the specification discloses a plurality of reagents, a plurality of reagent manufacturers, and a plurality of analytical apparatus manufacturers, with unapparent connections between these pluralities. Regarding drawings, from Figure 2 it is not clear, first, how the information for the reagents from company A becomes the one for company B? If it is an error of the drawing, and

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three floppy disks are supposed to correspond to companies A, B and C, then it is not clear, why does the information regarding items 2 and 4-5 of company A, items 1, and 3-4 of company B, and items 1, 6, 9 of company C disappear? Is it stored somewhere separately? The disclosure is completely confusing. If the specification was meant to disclose redistributing information about various reagents supplied by different manufacturers so that the information on the same reagent from different manufacturers were stored in the same place with the similar analytical tests to be performed for this reagent on the analytical instrument for its start-up, it failed to do so. If it meant to disclose something else, the examiner did not get an idea on what the subject matter of the specification should have been in this case. The specification will be interpreted by the examiner to her best ability.

4. The Abstract is objected to as being too lengthy (twenty lines versus fifteen allowed).

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### ***Drawings***

5. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to, because, first, they presumably contain errors (specifically Fig. 2 indicating only company A), and, second, they are not explanatory. Moreover, it seems that Figure 2 combines both conventional and inventive schemes at the same time, without clearly indicating the PRIOR ART portion. It also is not clear from the Figure, how direct downloading of three floppy disks with following utilizing the downloaded information by user X can be slower than downloading the same floppy disks first into the processing equipment, then recording parameters for user X floppy disk, and only then utilizing the information.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite the same expressions that were objected previously for the specification. The claims are rejected for the same reasons, i.e. non-clarity of such expressions as “registering parameters ... on an inspection item basis”, “the reagent-dependent parameters corresponding to the particular specification of the analytical apparatus”, etc. As it has been already mentioned, no clear explanation of such terminology is given in the specification.

Therefore, the examiner interprets the claims to her best ability.

#### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-6** are rejected under 35 U.S.C. 102(b) as being anticipated by the prior art disclosed in Lysakowski (US 5,434,971).

Lysakowski discloses in the Background of the Invention “the mechanism used for storing, retrieving and interpreting data”, which depends upon the data model. For example, “scientific data received in a computer from an instrument measuring physical quantities is represented by a data model having at least the following fields: physical quantity being measured; type of instrument; manufacturer; serial number; date of measurement; time of measurement; sample identification; and many fields for holding the data. The fields holding the data obtained by measuring physical quantities may be one dimensional if only a single number is recorded, or may be two dimensional if two numbers are recorded such as an independent variable and a dependent variable, or the fields may be multidimensional if several independent

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and dependent physical quantities are recorded” (col. 1, lines 54). “The computer media used for storage of the data include disk units on a local computer, servers on a computer network, disk farms on a computer cluster, magnetic disks reached over a computer communications network, optical storage units reached over a computer communications network, and other diverse computer storage media technologies. In all of these examples of data collected through the use of computer modules, the problem of exchanging data collected by different modules is particularly important” (col. 2, lines 1-10). Therefore, such disclosure intrinsically comprises steps of registering reagents from different manufacturers on the same instrument (for measuring physical (or chemical) quantities), and transferring the information to various servers.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. **Claims 1-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahmed et al. (US 4,819,176).

Ahmed discloses a method for registering parameters “by a system which includes a plurality of remote stations which implement various measuring functions on the raw material [reagents] being processed, for example weighing, while collecting identifying data of the production process such as work station identification, employee identification, work product identification and processing time. This collected data is transferred to a central computer by the remote stations for further analysis and evaluation. The computer analyzes the data collected to provide information regarding the quality of the raw material supplied by specific vendors, the quality of production for a particular job, the efficiency and quality of the employee's work and the effective yield from raw material to final product on a batch basis. One implementation of the processing line data acquisition system includes a first station which is a sorting station for sorting a batch of raw material by pre-selected criteria into a plurality of grades. The quantity of each of the sorted grades is measured, for example by weighing. The different grades of sorted material are then processed through a first processing step and the quantity, for example weight, is measured after the first processing step. A second processing step is then performed and the quantity, for example weight, of the twice processed material is also measured. A central computer is connected to the sorting and each of the measuring stations for collecting and correlating the measured quantities on a batch basis. Input and output identification indicia are provided at each of the stages such that the batch can be traced between the different processing stations so that the ultimate yield of the raw material to the finished product can be calculated even though different batches of different grades may be commingled” (col. 2, lines 59-68 and col. 3, lines 1-27).

While Ahmed does not specifically disclose his method for reagents, it would have been obvious for anyone of ordinary skill in the art to apply it to the chemical field, particularly analysis of reagents produced by different manufacturers, because it allows the same convenient storage of the information based on the reagent parameters rather than manufacturer data, which provides more flexibility in using the stored data.

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15. **Claims 1-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US 2002/0143725 A1).

Smith discloses “systems, methods and computer program products for determining parameters for chemical synthesis and for supplying the reagents, equipment and/or chemicals synthesized thereby” (Abstract). “As also shown in FIGS. 1E-1G, data entry 110, user query 120 and transactions 130 may be used separately according to embodiments of the present invention. Thus, in FIG. 1E, data entry 110 may be used to populate a database of a plurality of target chemicals, a plurality of corresponding listings of reagent chemicals, a plurality of corresponding listings of equipment and a plurality of corresponding listings of procedures. This database may include three related databases: a chemical database, an equipment database and a supplier database. As part of data entry, a plurality of target chemicals, a plurality of first pointers to a corresponding plurality of listings of reagent chemicals in the chemical database, a plurality of second pointers to a corresponding plurality of listings of equipment in the equipment database, and a plurality of corresponding listings of procedures are entered into the chemical database. The plurality of listings of equipment are entered into the equipment database, along with a plurality of third pointers to a corresponding plurality of listings of equipment suppliers in the supplier database” (col. 3, [0030]).

While Smith does not specifically disclose parameters on reagents from different suppliers, it would have been obvious for anyone of ordinary skill in the art to include such information in the database, i.e. to register reagents from different suppliers, in order to optimize the choice for their further usage.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yelena G. Gakh, Ph.D. whose telephone number is (571) 272-1257. The examiner can normally be reached on 9:30 am - 6:00 pm.

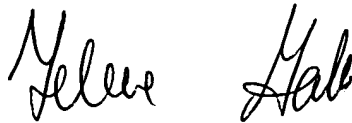
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yelena G. Gakh  
3/3/04

Handwritten signature of Yelena G. Gakh in black ink.

U.S. DEPARTMENT OF COMMERCE

PATENT AND TRADEMARK OFFICE

EXAMINER'S CASE ACTION WORKSHEET

Application No. 09/940,593		Legal Instrument Examiner
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CHECK TYPE OF ACTION

DATE OF COUNT

<input checked="" type="checkbox"/> Non-Final Rejection	<input type="checkbox"/> Restriction/Election Only	<input type="checkbox"/> Final Rejection
<input type="checkbox"/> Ex Parte Quayle	<input type="checkbox"/> Allowance	<input type="checkbox"/> Advisory Action
<input type="checkbox"/> Examiner's Answer	<input type="checkbox"/> Reply Brief Noted	<input type="checkbox"/> Non-Entry of Reply Brief
<input type="checkbox"/> Defective Notice of Appeal	<input type="checkbox"/> Interference Disposal SPE _____ (Approval for Disposal)	<input type="checkbox"/> Suspension (Examiner-Initiated) SPE _____ (initial)
<input type="checkbox"/> Defective Appeal Brief	<input type="checkbox"/> SIR Disposal (use only after FAOM)	<input type="checkbox"/> Supplemental Examiner's Amendment
<input type="checkbox"/> Miscellaneous Office Letter (With Shortened Statutory Period Set)	<input type="checkbox"/> Notice of Non-Responsive Amendment (With One Month Time Period set)	<input type="checkbox"/> Miscellaneous Office Letter (No Response Period Set)
<input type="checkbox"/> Abandonment after BPAI Decision	<input type="checkbox"/> Supplemental Action (excluding Examiner's Answer)	<input type="checkbox"/> Response to Rule 312 Amendment
<input type="checkbox"/> Letter Restarting Period for Response (e.g., Missing References)	<input type="checkbox"/> Interview Summary	<input type="checkbox"/> Authorization to Change Previous Office Action SPE: _____ (Initial)
<input type="checkbox"/> Abandonment	<input type="checkbox"/> Express Abandonment Date: _____	<input type="checkbox"/> Other Specify: _____

Examiner's Name: Yelena G. Gakh, Ph.D.

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